

[counsel listed on signature page]

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.

Case No. CV 10-03561 WHA (DMR)

Plaintiff,

**SECOND SUPPLEMENTAL JOINT  
PRETRIAL CONFERENCE  
STATEMENT**

V.

GOOGLE INC.

Date: December 21, 2011

Time: 8:00 a.m.

Dept.: Courtroom

## Defendant.

Judge: Honorable William H. Alsup

1 Pursuant to the Court's November 14, 2011 order, Oracle America, Inc. and Google Inc.  
 2 jointly submit this supplemental statement setting forth a proposed agenda for the pretrial  
 3 conference on December 21, 2011.

4 **1. Discussion of Court's Trial Plan**

5 The parties previously submitted their positions regarding the Court's plan to divide the  
 6 trial into three phases. (See 11/18/11 Oracle's Critique of Court's Proposed Trial Plan, Dkt. 627;  
 7 11/18/11 Google's Response to Proposed Trial Plan, Dkt. 628.)

8 *Oracle's Further Statement:* Oracle reiterates its opposition to bifurcating or trifurcating  
 9 the upcoming trial. Even while advocating for a trifurcated trial, Google acknowledges that the  
 10 witness testimony and other evidence will overlap to a considerable degree between the proposed  
 11 phases. Indeed, Google asks the Court for permission to videotape and replay witness testimony  
 12 in subsequent phases to avoid burdening witnesses with multiple appearances. Google's  
 13 suggestion only emphasizes the impracticality of phasing the presentation of evidence in this  
 14 case. If the trial is trifurcated, there will be no way to avoid repetition of testimony, whether by  
 15 calling witnesses multiple times or through some other means. A single presentation of evidence  
 16 would eliminate such repetition.

17 *Google's Further Statement:* Google reiterates its support for the Court's trifurcation  
 18 procedure. Google further believes resolution of the trial plan is essential before addressing trial  
 19 scheduling and time limits. Resolving the trial plan may also, if necessary, allow the Court to  
 20 defer until a later date: (a) at least some of the pending motions *in limine* (e.g., those seeking to  
 21 exclude patent-related evidence, which is not relevant to Phase 1); (b) supplemental claim  
 22 construction; (c) the marking issues; and (d) the procedure for color-coded handouts.

23 **2. Discussion of Trial Date**

24 The parties previously set forth their positions regarding the trial date and provided a list  
 25 of existing trial commitments of lead counsel. (See 12/7/11 Supp. Joint Pretrial Conference  
 26 Stmt., Dkt. 644 at 4-5.)

27 *Oracle's Further Statement:* Oracle reiterates its request for a trial date as early as  
 28 possible following the submission of Dr. Kearn's report on January 19, 2012. The continued

1 migration of device manufacturers and application developers from Java to Android is causing  
 2 irreparable harm to the Java platform that monetary damages alone cannot rectify. Android's  
 3 growth in the mobile device market has been exponential, steadily diminishing Java's share. For  
 4 instance, Amazon's newly-released Kindle Fire tablet is based on Android, while prior versions  
 5 of the Kindle were Java-based. Android has been gaining in other areas as well, with Android-  
 6 based set-top boxes and even televisions appearing this year. These are markets where Java has  
 7 traditionally been strong but is now losing ground to Android. The longer Android is allowed to  
 8 continue fragmenting the Java ecosystem, the more serious the harm to Java becomes, and the  
 9 more difficult it is to try to unwind. Oracle suffers harm in the form of lost licensing  
 10 opportunities for its existing Java platform products, and the enterprise-wide harm from  
 11 fragmentation of Java, which reduces the "write once, run anywhere" capability that has  
 12 historically provided Java such great value.

13       Google argues that Oracle cannot be irreparably harmed by Android because it has no  
 14 competing mobile platform of its own. This is wrong in at least two respects. First, Oracle's  
 15 predecessor, Sun Microsystems, had a Java-based mobile platform that it was forced to abandon  
 16 *because of Android*. When Google incorporated Java technology into Android and offered it for  
 17 free, Sun's mobile platform stood little chance. So long as Google continues to offer the Java  
 18 technology for free, Oracle cannot grow a fee-based mobile platform.

19       Second, as noted above, Android's growth is not limited to smartphone products.  
 20 Manufacturers of set-top boxes, tablets, and numerous other small-form-factor devices that  
 21 previously licensed Oracle's Java products, are adopting Android *to replace* Java ME and other  
 22 Oracle Java products. In essence, every day, Oracle is being forced to compete against its own  
 23 patented and copyrighted Java technology, that Google offers at zero cost to customers.

24       Google also argues that Java is actually thriving, since there are now 2.5 million more  
 25 Java developers since Oracle filed its complaint. What Google fails to mention is that many of  
 26 the new Java developers are writing applications *for the Android platform*, not for licensed Java  
 27 implementations. The rise of Android has increased the number of Java developers, but because  
 28 Android is unlicensed and incompatible with the Java platform, Oracle has not benefited. Instead,

1 Oracle is being irreparably harmed by the rapidly increasing penetration of Android and the  
 2 escalating fragmentation of the Java ecosystem it has caused.

3 Google's internal documents show Google deliberately made the choice to infringe,  
 4 gambling by pushing forward with Android without a license, even though it knew one was  
 5 required. That gamble increasingly pays off the longer trial is delayed—particularly if trial is  
 6 postponed a further seven months as Google requests. The parties' pre-trial filings were  
 7 submitted months ago. Oracle proposes that this case go to trial on January 20 or 23, 2012.

8 *Google's Further Statement:* Like Oracle, Google has no interest in delaying resolution of  
 9 this case any longer than necessary. Nor has Google done anything to delay the case. Indeed,  
 10 Google was prepared to try this case beginning in late October, at the original trial setting. And  
 11 Google is prepared to try the case at the earliest time available for the Court, the parties, and  
 12 counsel. That trial date ultimately depends on how long the trial is scheduled to last.

13 Even applying Oracle's requested times, the Court would need 4-5 weeks to try this  
 14 matter. Oracle seeks at least 28-30 hours of testimony per side—making this at least a 15-20 day  
 15 trial assuming separate openings, closings, and jury instructions for each proposed phase. On top  
 16 of that, the Court needs to budget adequate time for jury deliberations for each phase. Google  
 17 believes the parties will actually need close to 45 hours per side for trial—particularly if the  
 18 patent phase remains in its current posture (i.e., 26 claims from 6 unrelated patents)—such that  
 19 the time needed for trial is even longer. Thus, the prior commitments of the Court and trial  
 20 counsel preclude starting trial in late January 2012. Given those commitments and the possibility  
 21 of a trial totaling 5-6 weeks, it may be difficult to conduct trial before July 2012.

22 In any event, Oracle's claim of irreparable harm is incorrect, and does not require starting  
 23 trial in January 2012. First, Oracle has no competing mobile platform in the market, such that  
 24 there is no product that is being irreparably harmed. Second, Oracle's recent public statements  
 25 regarding Java belie any suggestion of irreparable harm from Android. For example, Oracle's  
 26 recent Java Facts and Figures suggest that Java is thriving:  
 27  
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1                   **Java Facts and Figures**

2                   • 97% of enterprise desktops run Java  
 3                   • 1 billion Java downloads each year  
 4                   • 9 million developers worldwide  
 5                   • #1 programming language (TIOBE Programming Community Index)  
 6                   • More than 3 billion devices are powered by Java technology

7                   <https://emeapressoffice.oracle.com/Press-Releases/Oracle-Continues-to-Move-Java-Forward-and-Details-Java-SE-8-Roadmap-23ce.aspx> (last visited December 17, 2012). Notably, the Java developer figure has grown by 2.5 million since Oracle filed its Complaint in this matter. (See Compl. ¶ 9.) Oracle contends that many of these developers are writing for Android, with no benefit to Oracle. But this is inconsistent with the fact that Oracle touts these figures. In fact, Android does benefit Oracle by broadening the number of developers using the Java programming language, which Oracle concedes is not protected. Third, Oracle elected not to move for a preliminary injunction, which suggests a lack of irreparable harm from Google's continued distribution of Android.

15                  In sum, Google also proposes trying this case as early as possible. That trial date will depend on resolving the format and length of trial, in combination with any scheduling issues for the Court, the parties, and counsel. At a minimum, those factors rule out starting trial in January.

16                  **3. Time Limits for Opening Statement, Witness Examination, Closing Argument**

17                  *Oracle's Statement:* As set forth previously, Oracle requests a minimum of 28-30 hours per side for direct and cross examination. Oracle proposes 1 hour per side for opening statements, and 2 hours per side for closing arguments.

18                  *Google's Statement:* Based on the Court's tentative trial plan, Google requests a minimum of 15 hours per side for direct and cross examination for each phase of trial. Also based on the Court's tentative trial plan, Google proposes an opening statement of 45 minutes and closing argument of 1.5 hours per side for each of the three trial phases. At least this much time is necessary for Phase 1, which will introduce the parties and the numerous copyright issues. And since Oracle continues to assert 26 claims from six unrelated patents, the parties will need at least

1 that much time for Phase 2. The same goes for Phase 3, which is set to cover both damages and  
 2 willfulness.

3       **4. Oral Argument on Selected Motions in Limine**

4       At the Court's request, the parties selected the following four motions in limine for oral  
 5 argument at the pretrial conference (*see* 12/7/11 Supp. Joint Pretrial Conference Stmt., Dkt. 644  
 6 at 1):

- 7           • Oracle's Motion in Limine No. 1 to Exclude Evidence or Argument Regarding  
                   Patent Reexaminations. (Motion, Dkt. 498; Opposition, Dkt. 498-1.)
- 8           • Oracle's Motion in Limine No. 4 to Exclude Evidence or Argument Regarding  
                   Oracle's Past Actions with Application Programming Interfaces. (Motion, Dkt.  
                   501; Opposition, Dkt. 501-1.)
- 9           • Google's Motion in Limine No. 1 to Exclude Lindholm E-mail and Drafts  
                   Thereof. (Motion, Dkt. 492; Opposition, Dkt. 492-1.)
- 10          • Google's Motion in Limine No. 3 to Exclude Portions of Cockburn Report on  
                   Damages. (Motion, Dkt. 494; Opposition, Dkt. 494-1.)

11       For the Court's convenience, the other motions in limine filed by the parties are listed  
 12 below:

- 13          • Oracle's Motion in Limine No. 2 to Exclude Evidence or Argument That Google  
                   Relied on Legal Advice in Making Its Decisions to Develop and Release Android.  
                   (Motion, Dkt. 499; Opposition, Dkt. 499-1.)
- 14          • Oracle's Motion in Limine No. 3 to Preclude Google from Offering Evidence or  
                   Argument That Third-Party OEMs Changed Infringing Components of Android.  
                   (Motion, Dkt. 500; Opposition, Dkt. 500-1.)
- 15          • Oracle's Motion in Limine No. 5 to Exclude Evidence and Contrary to Statements  
                   in Tim Lindholm's August 6, 2010 E-mail. (Motion, Dkt. 502; Opposition, Dkt.  
                   502-1.)
- 16          • Google's Motion in Limine No. 2 to Exclude Alleged Performance Benefits of  
                   Android With the Accused Functionality. (Motion, Dkt. 493; Opposition, Dkt.  
                   493-1.)
- 17          • Google's Motion in Limine No. 4 to Exclude Portions of Goldberg Report  
                   Discussing Commercial Success. (Motion, Dkt. 495; Opposition, Dkt. 495-1.)
- 18          • Google's Motion in Limine No. 5 to Exclude Evidence Obtained from Motorola  
                   Mobility, Inc. (Motion, Dkt. 496; Opposition, Dkt. 496-1.)

1           **5. Status of Re-Examinations and Writ Petition**

2           The parties previously set forth the status of the re-examination proceedings before the  
 3 U.S. Patent and Trademark Office. (*See* 12/7/11 Supp. Joint Pretrial Conference Stmt., Dkt. 644  
 4 at 1-3.) The parties also previously set forth the status of Google's petition for a writ of  
 5 mandamus before the U.S. Court of Appeals for the Federal Circuit. (*See id.* at 3-4.) The status  
 6 of both the USPTO and Federal Circuit proceedings has not changed since the parties' prior  
 7 submission to the Court.

8           **6. Procedure for Equitable Defenses**

9           Google is asserting laches, equitable estoppel, waiver, and implied license as defenses to  
 10 Oracle's patent and copyright claims. Google has requested that the Court allow the jury to  
 11 render an advisory verdict on these equitable defenses. Oracle opposes this request. The  
 12 respective positions of the parties on this issue are set forth in the trial briefs (*see* Oracle Brief,  
 13 Dkt. 536 at 26-27; Google Brief, Dkt. 534 at 24-25.)

14           **7. Procedure for Submitting Evidence Regarding Oracle's Requested Injunctive  
 15 Relief**

16           Oracle seeks injunctive relief against Google, an equitable remedy to be decided by the  
 17 Court. Google opposes this request. The parties seek the Court's guidance regarding whether  
 18 evidence relating to the propriety and extent of injunctive relief must all be presented during the  
 19 jury trial, or whether the Court intends to hold a post-trial hearing during which such evidence  
 20 may be presented.

21           **8. Procedure for *Voir Dire***

22           The parties have submitted proposed questions for use in the *voir dire* process. (Dkt.  
 23 520.) The parties believe that a juror questionnaire would improve the speed and efficiency of the  
 24 *voir dire* process. The parties will bring a proposed questionnaire to the pretrial conference for  
 25 the Court's consideration.

26           **9. Procedure Regarding Patent Marking Issues**

27           Pursuant to the Court's December 6, 2011 order (Dkt. 641), the parties will provide a joint  
 28 submission on December 20, 2011, regarding the procedure for addressing the Oracle and Sun

1 products that the parties contend practice the asserted patent claims and whether and when they  
2 were marked.

3       **10. Supplemental Claim Construction**

4       The parties have submitted their proposed constructions of three additional claim terms.  
5 (Dkt. 637.) The parties have also filed their respective objections to the other party's proposed  
6 constructions. (Dkt. 645, 647.) The parties will be prepared to address these issues at the pretrial  
7 conference if the Court desires.

8       **11. Procedure for Joint Color-Coded Handouts**

9       Pursuant to the Court's orders, the parties submitted joint color-coded handouts  
10 highlighting disputed elements in the asserted patent claims; i.e., elements that Google contends  
11 are missing from the accused products and elements that Oracle contends are missing from the  
12 preferred prior art. (Dkt. 633.) The parties seek guidance on how these handouts should be used  
13 at trial.

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1 Dated: December 19, 2011

MORRISON & FOERSTER LLP

2 By: /s/ Michael A. Jacobs

3  
4 MORRISON & FOERSTER LLP  
5 MICHAEL A. JACOBS (Bar No. 111664)  
mjacobs@mofo.com  
6 KENNETH A. KUWAYTI (Bar No. 145384)  
kkuwayti@mofo.com  
7 MARC DAVID PETERS (Bar No. 211725)  
mdpeters@mofo.com  
8 DANIEL P. MUINO (Bar No. 209624)  
dmuino@mofo.com  
755 Page Mill Road  
9 Palo Alto, CA 94304-1018  
Telephone: (650) 813-5600  
Facsimile: (650) 494-0792

10  
11 BOIES, SCHILLER & FLEXNER LLP  
12 DAVID BOIES (Admitted *Pro Hac Vice*)  
dboies@bsfllp.com  
13 333 Main Street  
Armonk, NY 10504  
14 Telephone: (914) 749-8200  
Facsimile: (914) 749-8300  
15 STEVEN C. HOLTZMAN (Bar No. 144177)  
sholtzman@bsfllp.com  
1999 Harrison St., Suite 900  
16 Oakland, CA 94612  
Telephone: (510) 874-1000  
Facsimile: (510) 874-1460

17  
18 ORACLE CORPORATION  
19 DORIAN DALEY (Bar No. 129049)  
dorian.daley@oracle.com  
20 DEBORAH K. MILLER (Bar No. 95527)  
deborah.miller@oracle.com  
21 MATTHEW M. SARBORARIA (Bar No.  
211600)  
matthew.sarboraria@oracle.com  
22 500 Oracle Parkway  
Redwood City, CA 94065  
23 Telephone: (650) 506-5200  
Facsimile: (650) 506-7114

24  
25 *Attorneys for Plaintiff*  
26 ORACLE AMERICA, INC.  
27  
28

1 Dated: December 19, 2011

KEKER & VAN NEST, LLP

2 By: /s/ Robert A. Van Nest

3 ROBERT A. VAN NEST (SBN 84065)  
4 rvannest@kvn.com  
5 CHRISTA M. ANDERSON (SBN184325)  
canderson@kvn.com  
6 DANIEL PURCELL (SBN 191424)  
dpurcell@kvn.com  
7 710 Sansome Street  
San Francisco, CA 94111-1704  
Telephone: (415) 391-5400  
Facsimile: (415) 397-7188

8  
9 SCOTT T. WEINGAERTNER (*Pro Hac Vice*)  
sweingaertner@kslaw.com  
10 ROBERT F. PERRY  
rperry@kslaw.com  
11 BRUCE W. BABER (*Pro Hac Vice*)  
bbaber@kslaw.com  
12 1185 Avenue of the Americas  
New York, NY 10036-4003  
Telephone: (212) 556-2100  
Facsimile: (212) 556-2222

13  
14 DONALD F. ZIMMER, JR. (SBN 112279)  
fzimmer@kslaw.com  
15 CHERYL A. SABNIS (SBN 224323)  
csabnis@kslaw.com  
16 KING & SPALDING LLP  
17 101 Second Street - Suite 2300  
San Francisco, CA 94105  
18 Telephone: (415) 318-1200  
Facsimile: (415) 318-1300

19  
20 GREENBERG TRAURIG, LLP  
IAN C. BALLON (SBN 141819)  
ballon@gtlaw.com  
21 HEATHER MEEKER (SBN 172148)  
meekerh@gtlaw.com  
1900 University Avenue  
22 East Palo Alto, CA 94303  
Telephone: (650) 328-8500  
Facsimile: (650) 328-8508

23  
24 *Attorneys for Defendant*  
GOOGLE INC.

## ATTESTATION

I, Michael A. Jacobs, am the ECF User whose ID and password are being used to file this SECOND SUPPLEMENTAL JOINT PRETRIAL CONFERENCE STATEMENT. In compliance with General Order 45, X.B., I hereby attest that Robert A. Van Nest has concurred in this filing.

Date: December 19, 2011

*/s/ Michael A. Jacobs*